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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/972,713      | 10/05/2001  | Richard A. Fox       |                     | 4498             |

7590 03/21/2003

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EXAMINER

YOUNG, MICAH PAUL

| ART UNIT | PAPER NUMBER |
|----------|--------------|
| 1615     | #7           |

DATE MAILED: 03/21/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |                              |                  |
|------------------------------|------------------------------|------------------|
| <b>Office Action Summary</b> | Application No.              | Applicant(s)     |
|                              | 09/972,713                   | FOX ET AL.       |
|                              | Examiner<br>Micah-Paul Young | Art Unit<br>1615 |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 19 December 2002.

2a) This action is **FINAL**.      2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 18-20 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 18-20 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.

    If approved, corrected drawings are required in reply to this Office action.

12) The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. §§ 119 and 120

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a) All    b) Some \* c) None of:

    1. Certified copies of the priority documents have been received.

    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.

    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    \* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

    a) The translation of the foreign language provisional application has been received.

15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

#### Attachment(s)

|   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                   | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)          | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____. | 6) <input type="checkbox"/> Other: _____                                    |

## DETAILED ACTION

**Acknowledgment of Papers Received:** Extension of time and Response filed 12/19/02.

Claims 1- 17 have been canceled by amendment and claims 18 – 20.

### *Claim Rejections - 35 USC § 112*

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 18 – 20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claims recite a “crystalline emulsion” yet it is unclear to the examiner how a composition can be both crystalline and emulsified simultaneously.

The claims recite the emulsion contains a catalyst yet no catalyst is named.

Further, claim 20 recites the limitation "the coated crystals" in steps b and c of the process. There is insufficient antecedent basis for this limitation in the claim. It is unclear to the examiner at which point during the process the crystals are coated.

### *Claim Rejections - 35 USC § 103*

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

3. Claims 18 – 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schmidt et al (USPN 4,440,745) in view of Brieva et al (USPN 5,800,816). Claims 18 and 19 are drawn to an emulsion comprising magnesium oxide crystals coated with methicone. Claim 20 is drawn to a method of making the emulsion comprising making a slurry of the crystals, and methicone, baking the slurry and mixing the result with a emulsion carrier.

Schmidt et al discloses an abrasive emulsion where the abrasive crystals can be oxides of well known compounds such as Mg, Al, Ca, and Si (col. 2, lin. 63 – 68; col. 4, lin. 13 – 23). The reference discloses the abrasives are useful as toothpaste or in an acne treatment (col. 1, lin. 46 – 51). The reference suggests the inclusion of silicone oils (col. 3, lin. 60 – 65). The reference also teaches that the abrasives can be carried in an emulsion and is prepared by mixing and drying the resultant at a temperature of 110°C (230 °F), and further mixing the dried particles with an appropriate carrier (examples).

What is lacking from the reference is a teaching of the particular silicone additive used in the composition. Methicone is a well-known and used component of cosmetic compositions.

This is seen in Brieva et al, who teaches a cosmetic composition where magnesium oxide particles are mixed with methicone (col. 3, lin. 50 – 62; col. 4, lin. 56 – 68). It would have been obvious to one of ordinary skill in the art to follow the suggestions in the art to arrive at the claimed invention. Schmidt provides motivation to include silicon oils to coat and lubricate the particles. A skilled artisan would have included the methicone as seen in Brieva in order to provide proper lubrication to the abrasive particles. It would have been obvious to combine these teachings at the time of the invention with an expected result of an abrasive emulsion useful in the treatment of skin conditions.

#### *Response to Arguments*

4. Applicant's arguments with respect to claims 1- 17 have been considered but are moot in view of the new ground(s) of rejection.

In response to applicant's argument that the emulsion is used for microdermabrasion/skin debridement rather than a cosmetic cover, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

Applicant argues that the compositions of Schmidt and Brieva are elegant cosmetics while the instant invention is a “gritty, feelable” composition. In response to this argument it is noted that the features upon which applicant relies (i.e., a gritty, feelable consistency) are not

recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Furthermore the argument that the present invention is “gritty and feelable” does not differentiate the claimed invention from the prior art. It is the position of the examiner that such limitations are arbitrary functional language, with regard to the present invention absent a comparison with the prior art. The burden has been shifted to the applicant to provide sufficient evidence that distinguishes the present application from the prior art. Limitations such as particle size, and specific component would help distinguish the present invention. Also a showing of unexpected results would also distinguish the present invention from the prior art.

### ***Conclusion***

5. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Micah-Paul Young whose telephone number is 703-308-7005. The examiner can normally be reached on M-F 7:30am-4: 30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thurman K Page can be reached on 703-308-2927. The fax phone numbers for the organization where this application or proceeding is assigned are 703-746-7648 for regular communications and 703-746-7648 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1234.

Micah-Paul Young  
Examiner  
Art Unit 1615

M. Young  
February 27, 2003

  
Gajendra S. Kishore, PhD  
Primary Examiner  
Group 1600